

REMARKS:

Claims 1-41 remain in the application for consideration of the Examiner.

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in light of the following remarks.

REJECTIONS UNDER 35 U.S.C. § 103:

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) over International Application Publication No. WO 00/17795 to Kennedy, et al. ("Kennedy") in view of U.S. Patent Application Publication No. 2001/0047285 to Borders ("Borders").

However, for the reasons discussed below, the proposed combination of Kennedy and Borders fails to render claims 1-41 obvious. Therefore, it is respectfully requested that the rejection be reconsidered and withdrawn.

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP 2142. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *Id.*

Thus, in order to establish a *prima facie* case of obviousness, an office action must include, based on factual support, a showing that (1) there is some suggestion or motivation to modify a reference or combine reference teachings, (2) there is a reasonable expectation of success, and (3) all claim limitations are taught or suggested by prior art.

1. Disqualification of Borders as Prior Art

The present application was filed on 4 October 2001 and claims priority to U.S. Provisional Patent Application No. 60/238,307 filed on 5 October 2000, thus resulting in an effective filing date of 5 October 2000. Borders was later filed on 16 March 2001. Because the filing date of Borders is after the effective filing date of the present application, Borders is not properly citable as prior art under 35 U.S.C. §§ 102 and 103. It is noted, however, that Borders claims priority to earlier provisional applications. If the Examiner intends to rely on one or both of the filing dates of the provisional applications, then it is respectfully requested that a showing under MPEP 2136.03 be made that "the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."

2. Lack of Suggestion or Motivation to Modify or Combine

With respect to the first element (i.e., suggestion or motivation to modify), it is respectfully submitted that the present Office Action fails to include a showing based on factual support that there exists any suggestion or motivation to combine the teachings of Kennedy and Borders. First, the Office Action refers to "teaching of Asthana," however, it is unclear what the Office Action is referring to since there is no such teaching of record in the present Application. The Office Action states that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the available promise servers of Kennedy to include the consolidated product availability taught by Borders in order to facilitate grouping order into loads." However, the Office Action does not explain *why* it would have been obvious to make this modification. Instead, the conclusion that such a combination would "facilitate grouping order into loads" seems to be based on impermissible hindsight reasoning based on the disclosure of the present Application. Thus, the Office Action provides no suggestion or motivation for combining Kennedy and Borders. Therefore, for at least this reason, it is respectfully submitted that the Office Action fails to establish a *prima facie* case of obviousness.

3. Lack of Reasonable Expectation of Success

With respect to the second element (i.e., reasonable expectation of success), the Office Action is silent with respect to this element. Therefore, for at least this additional reason, it is respectfully submitted that the Office Action fails to establish a *prima facie* case of obviousness.

4. All Claim Limitations Are Not Taught or Suggested

With respect to the third element (i.e., all claim limitations being taught or suggested by prior art), the Office Action fails to show that all elements of the present claims are taught or suggested by prior art.

As previously pointed out, Kennedy fails to disclose or suggest at least the following limitations as recited in claim 1:

- (a) a local database for storing consolidated product availability information; and
- (b) the consolidated availability information stored in the database allows a component quotation to be generated without retrieving product availability information from ATP servers in response to a component ATP request.

While the Office Action seems to concede these points and rely on Borders for these deficiencies of Kennedy, the Office Action provides no concrete discussion of how Borders is considered to teach these limitations, particularly in such a way that it would have been obvious to modify Kennedy to include such features. A review of Borders revealed no such teachings, and no specific portions of Borders are cited in the Office Action. Thus, the proposed combination of Kennedy and Borders fails to disclose or suggest all of the limitations of claim 1. Accordingly, for at least this reason, the proposed combination of Kennedy and Borders cannot render claim 1 obvious.

Claims 22-41

With respect to independent claims 22, 39, 40, and 41, each of these claims includes limitations similar to those discussed above in connection with claim 1. Thus, the

arguments presented above in connection with claim 1 apply equally to claims 22, 39, 40, and 41, as well as their dependent claims.

For the reasons set forth herein, the Applicants submit that claims 1-41 are not rendered obvious by the proposed combination of Kennedy and Borders. The Applicant further submits that claims 1-41 are in condition for allowance. Therefore, the Applicant respectfully requests that the rejection of claims 1-41 be reconsidered and that claims 1-41 be allowed.

LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent

criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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